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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,911	11/14/2003	Jack Robert Arron Clark	03.040.01	7656
7590 Zilka-Kotab, PC P.O. Box 721120 San Jose, CA 95172-1120			EXAMINER MURDOUGH, JOSHUA A	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 02/18/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,911

Applicant(s)

CLARK, JACK ROBERT ARRON

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/24/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-12,14,15,17-22,24,25,27-32,34,35 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-12,14,15,17-22,24,25,27-32,34,35 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination ("RCE") under 37 C.F.R. § 1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant's submission filed on 24 November 2008 has been entered.

Acknowledgements

2. This action is responsive to Applicant's RCE and associated amendment received 24 November 2008.
3. Claims 1, 2, 4, 5, 7-12, 14, 15, 17-22, 24, 25, 27-32, 34, 35, and 37-44 are pending and have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 7, 10-12, 14, 17, 20-22, 24, 27, 30-32, 34, 37, and 40-44 rejected under 35 U.S.C. §103(a) as being unpatentable over Eglen (US 2003/0023505) in view of Hurtt (US 7,330,711).

6. As to claims 1, 11, 21, and 31, Eglen shows:

- a. A method for distributing a computer program product, said method comprising the steps of:
- b. obtaining a licence ticket ("ticket," [0162] bearing a licence key ("serial number," Id.);
- c. inputting at a user computer (**124** and **108** are both used to show a user computer/device, see Figure 1) a download source computer address ("address," [0059]) of a download source computer of a supplier **222** of said computer program product ("customer device 124 can download a...software program," [0053]);
- d. establishing a computer network connection between said user computer **108** and said download source computer **222** (Figure 2);
- e. inputting said licence key at said user computer (tickets are physically delivered or printed with a serial number for authentication [0162], in order to authenticate the ticket's serial number, the serial number has to be provided by the user, as the user is using their computer to download software, the serial number has to be input on their computer.);

- f. transmitting said licence key from said user computer to said download source computer (request following the path, 250 to 254 to 262, Figure 2) via said computer network connection (Figure 2);
 - g. validating said licence key sent to said download source computer (the serial number is "authentication information," [0162]); and
 - h. if said licence key is valid (always considered true as the previous step validated the key), then:
 - (i) downloading **264** said computer program product to said user computer (Figure 2 & [0145]);
and
 - (ii) installing said computer program product to be resident upon said user computer (store content, [0053]);
 - i. wherein when said licence ticket is purchased a seller **102** of said licence ticket transmits data indicating sale of said licence ticket to said supplier **116** of said computer program product ("supplier of the work is compensated," [0158]);
7. Eglen does not expressly show:
- wherein receipt of said data indicating sale of said licence ticket triggers said supplier of said computer program product to charge said seller for a licence to use said computer program product.
8. However, Hurtta shows a serving GPRS support node ("SGSN") sending a message to a General Packet Radio Service ("GPRS") which triggers the GPRS to charge the SGSN for the usage reported (C 6, LL 58-65). Therefore, it would have been obvious to one of ordinary skill

in the art at the time of the invention to have modified the teachings of Eglen to include the charging taught by Hurta. This would allow the supplier to only have to pay for the rights used. Moreover, it would encourage the supplier to carry the license tickets in their inventory as the overhead associated with the license ticket is greatly reduced because the seller would not have to pay upfront.

9. As to claims 2, 12, 22, and 32, Eglen further shows:

said licence ticket is obtained via a purchase by a user ("User," 108, Figure 2).

10. As to claims 4, 14, 24, and 34, Eglen further shows:

said receipt of said data indicating sale of said licence ticket validates said licence key associated with said licence ticket such upon subsequent receipt of said licence key at said download source computer said licence key will be treated as valid (As described, the serial number is either a valid number issued or fraudulent [0162]. Therefore, regardless of the data indicating sale, the serial number will always be valid if it is not fraudulent.)

11. As to claims 7, 17, 27, and 37, Eglen further shows:

if said licence key is valid, then a user account (312, Figure 3 & [0066]) is created associated with said licence key ("the database servers 208 track the purchases made and administer user accounts," [0067]).

12. As to claim 41, Eglen further shows:

said licence ticket includes a front side and a back side (inherent to printed material such as that described in [0162]).

13. As to claim 42, Eglen further shows:

said licence ticket includes a bar code ("bar code," [0162]) identifying said licence ticket ("authentication information," [0162]).

14. As to claims 10, 20, 30, 40, and 43, Eglen further shows:

validating said licence key includes comparing said licence key with a list of valid licence keys (authentication information is used to check for validity [0162] to authenticate the information is simply compared to the list of valid issued serial numbers).

15. Eglen in view of Hurtt teaches a paper license ticket. However, it does not expressly teach the specific printed data recited in claim 44. Nevertheless, the difference(s) are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217

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USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994);

MPEP § 2106.

16. Claims 8, 9, 18, 19, 28, 29, 38, and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Eglen/Hurtta combination as applied to claims 1, 11, 21, and 31 above, and further in view of Ishibashi (US 7,124,443).
17. The showings of the Eglen/Hurtta combination are shown above in regards to claims 1, 11, 21, and 31.
18. The Eglen/Hurtta combination does not expressly show:
 - j. said licence key is hidden upon said licence ticket so as to be non-reversibly revealable by a user; and
 - k. said licence key is hidden behind a scratch off covering upon said licence ticket.
19. Ishibashi shows:
 - l. said licence key is hidden upon said licence ticket so as to be non-reversibly revealable by a user (C 8, LL 65-67); and
 - m. said licence key is hidden behind a scratch off covering upon said licence ticket (Id.) .
20. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Eglen to include the scratch off covering over the serial number, as taught by Ishibashi. This would make it so the serial number cannot be seen by someone other than the intended user without leaving evidence to the fact. Also, it

would prevent resale of license tickets that have already been used, as the potential buyer would see that the serial number was already revealed.

21. Claims 5, 15, 25, and 35 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Eglen/Hurtta combination as applied to claims 1, 11, 21, and 31 above, and further in view of Christiano (US 5,671,412).

22. The showings of the Eglen/Hurtta combination are shown above in regards to claims 1, 11, 21, and 31.

23. The Eglen/Hurtta combination does not expressly show:

said data indicating sale of said licence ticket indicates one or more computer program products of which download and installation is to be allowed by said licence key of said licence ticket.

24. Christiano shows a package certificate (18, Figure 2b) that indicates a list of components 26 with a component name 34 and a key 33. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Eglen to include the computer products of which download and installation is to be allowed by a key in the data indicating the sale. This allows for more thorough accounting records. Also, the supplier can see exactly how many of each product has been purchased to help make business decisions regarding capital expenditures for support and upgrades.

Definitions

25. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

Associate: “4 : to bring together or into relationship in any of various intangible ways (as in memory or imagination).” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Authenticate: “:to prove or serve to prove the authenticity of” “syn see CONFIRM.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Key: “2a: a means of gaining or preventing entrance, possession, or control.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Validate: “2: to support or corroborate on a sound or authoritative basis” “syn see CONFIRM.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

Response to Arguments

26. Applicant's arguments with respect to claims 1, 2, 4, 5, 7-12, 14, 15, 17-22, 24, 25, 27-32, 34, 35, and 37-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. Homgren (Introduction to Financial Accounting) and White (Uniform Commercial Code) have both been provided as showing standard practices for billing, charging, and other accounting principals. Of particular importance in these references are the discussions on consignment.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

30. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621